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| 09/476,415   | 12/30/1999  | DALE SANDBERG        | 3855.29                       | 7821                   |
| 21999  | 7590        | 08/29/2007           |                               |                        |
| KIRTON AND MCCONKIE<br>60 EAST SOUTH TEMPLE,<br>SUITE 1800<br>SALT LAKE CITY, UT 84111 |             |                      | EXAMINER<br>ALTSCHUL, AMBER L |                        |
|  |             |                      | ART UNIT<br>3626              | PAPER NUMBER           |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/476,415

Applicant(s)

SANDBERG, DALE

Examiner

Amber L. Altschul

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-29, 32-38 and 40-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-29, 32-38, and 40-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the amendment filed on May 29, 2007. Claims 21-29, 32-38, and 40-43 remain pending. Claims 21, 33, and 42 have been amended.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 21-29, 32-38, and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans (5,924,074) in view of Feldon et al. (5,732,221), Lavin et al. (5,772,585), Provost et al. (6,341,265), and Lancelot et al. (6,434,531).

(A) As per claims 21-22, 24-25, and 32, Evans discloses a medical records method and system for storage and retrieval of dynamic electronic medical records in a computer environment, such as a local or wide area network including portable computers (col. 1 lines 5-10), wherein patient data, such as patient complaints, lab orders, medications, diagnoses, and procedures, are captured at the point of care of a patient in real-time, such as during an examination or in hospital (see Figure 24), using a graphical user interface having touch screens in a point of care system (Abstract; lines 1-5; col. 2 lines 20-64, col. 5 lines 29-55, and col. 5 lines 8-10), comprising:

(a) selecting a procedure from a list of procedures administered by a physician of a healthcare facility, wherein the procedures reflect treatments of a physician, and wherein the

procedures are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64);

(b) selecting a diagnosis from a list of diagnoses made by a physician of a healthcare facility, wherein the diagnosis indicates the proper administration of procedures to be performed by a physician, and wherein the diagnoses are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64);

(c) activating the form for use by a health care provider when diagnosing and performing a procedure or administering a treatment on a patient (Figures 1,5-6, 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64);

(d) determining a particular sequence of the pool of healthcare procedures based upon user preferences (Figure 20, the doctor can select the sequence of the procedures displayed on the form);

(e) using the form to select a procedure, wherein the procedures reflect treatments of a physician, and wherein the procedures are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64) and to select a diagnosis from a list of diagnoses made by a physician of a healthcare facility, wherein the diagnosis indicates the proper administration of procedures to be performed by a physician, and wherein the diagnoses are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64).

Evans fails to expressly recite a “customizable form”.

Feldon discloses entering a patient’s demographic information, medical history, prescribed medication and other relevant information for a patient, including information a physician documents during the exam using exam descriptors, into data entry forms, wherein a

user is able to customize these data entry forms by editing existing forms or by redesigning completely new forms, wherein the form is able to be saved using a computer (Figure 1, col. 4 lines 13-63, col. 8 lines 62-67, and col. 9 lines 15-65, col. 11 lines 1-58, and col. 12 lines 1-9).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include the aforementioned features of Feldon within the method of Evans with the motivation of allowing forms to be generated based on the user's needs and customized for the particular task at hand (Feldon; col. 4 lines 52-54) and transforming a patient chart from a static record of a few clinical interactions into a dynamic, real-time comprehensive record (Evans; col. 2 lines 34-40).

Evans and Feldon fail to expressly disclose patients wherein the step for generating the customizable form comprises: defining display specifications that relate to i) a display of the healthcare procedures characteristically performed by the particular healthcare provider and (ii) a display of the healthcare diagnoses characteristically performed by the particular healthcare provider, and wherein the display specifications are based on individual user preference.

Lavin discloses creating a customized list for a health care provider's practice specialty, wherein the customized list relates to diagnoses and procedures used in the specialty (reads on "a display of the healthcare procedures characteristically performed by the particular healthcare provider" and "a display of the healthcare diagnoses characteristically performed by the particular healthcare provider, and wherein the display specifications are based on individual user preference") (Figure 13, col. 9 lines 29-40). Further, Lavin discloses creating and viewing the customized list in a graphical user interface (reads on "customizable form") (Fig. 17, col. 3 line 65 to col. 4 line 17, col. 13 lines 28-59).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Lavin within the method taught collectively by Evans and Feldon with the motivation of maximizing the efficiency and effective use of the physician's time (col. 15 lines 46-59) by providing customized lists created for a particular physician's practice specialty (Fig. 13).

Evans, Feldon, and Lavin fail to expressly disclose using the customizable form to display billing information prior to the rendering of the one of the procedures on the patient to allow the healthcare provider to advise the patient as to healthcare service to be rendered, including the most cost efficient healthcare alternative for the patient, and wherein the step for using the customizable to display billing information is performed during an examination of the patient, and wherein the step for using the customizable form to display billing information includes allowing the healthcare provider to selectively adjust the cost of rendering the one of the procedures at the time of the examination of the patient.

Provost discloses a claim form for entering patient information, including insurance plan information, diagnosis codes, treatment codes, wherein the dollar amounts for a treatment code are displayed, wherein the dollar amounts can be displayed in a short amount of time which is limited by data transmission rates, wherein the patient is able to present because the dollar amounts can be collected from the patient in the office, wherein the physician may provide alternative treatments which are approved for payment by an insurance plan (Abstract, Fig. 3, 4A, 4B, col. 8 line 32 to col. 12 line 14).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Provost within the method taught collectively by Evans,

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Feldon, and Lavin with the motivation of reducing the number of insurance claims that are rejected by an insurance company (Provost; col. 2 lines 27-57) and decreasing the amount of time to determine whether a claim will be paid (Provost; col. 2 lines 27-57).

Evans, Feldon, Lavin, and Provost fails to expressly disclose:

using a computer interface to define a new structure for the customizable form that is not generated from a printed data form, selecting a number of rows for inclusion into the customizable form, defining specifications relating to the pool of healthcare procedures and to the one or more healthcare diagnoses, and displaying the customizable form in a definition window.

Lancelot discloses using a computer interface to define a new structure for the customizable form that is not generated from a printed data form (Fig. 4, 6, 11, col. 9 line 64 to col. 11 line 7, col. 12 lines 7-15, col. 15 line 35 to col. 16 line 6), selecting a number of rows for inclusion into the customizable form (Fig. 4, 6, 11, col. 9 line 64 to col. 11 line 7, col. 12 lines 7-15, col. 15 line 35 to col. 16 line 6), defining specifications relating to the pool of healthcare procedures and to the one or more healthcare diagnoses (Fig. 4, 6 col. 10 lines 14-21, col. 15 line 35 to col. 16 line 6), and displaying the customizable form in a definition window (Fig. 4, 6, 11, col. 9 line 64 to col. 11 line 7, col. 12 lines 7-15, col. 15 line 35 to col. 16 line 6).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Lancelot within the method taught collectively by Evans, Feldon, Lavin, and Provost with the motivation of allowing for the tailoring of templates (or forms) based on the requirements for a given patient (Lancelot; col. 1 lines 53-60).

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(B) As per claim 23, Evans discloses a data interface permitting communication with external sources to obtain patient data and to transfer patient information to external health care providers, such as demographic data, laboratory test results, x-ray images, ICD9 diagnosis codes and CPT procedure codes, prescriptions for medications (col. 9 lines 1-14). The remainder of claim 23 repeats the same limitations as claim 21, and is therefore rejected for the same reasons given for claim 21, and incorporated herein. It is noted that the step of transferring patient information, including ICD9 diagnosis codes and CPT procedure codes, to external health care providers (col. 9 lines 1-14) is considered to be a form of “one or more other healthcare procedures or diagnoses used by another healthcare provider of a healthcare facility” as recited in claim 23.

(C) As per claim 26, Feldon discloses customizing data entry forms for a physician, for example for an examination of the eye by defining common types of eye exams (col. 1 line 20 to col. 2 line 12 and col. 4 lines 30-45). The remainder of claim 26 repeats the same limitations as claim 21, and is therefore rejected for the same reasons given for claim 21, and incorporated herein. The motivation for combining Feldon within Evans is given above in claim 21, and is incorporated herein.

(D) As per claim 27-29, Evans discloses entering and updating a patient record using a form, wherein the patient record includes insurance information, ICD9 diagnosis codes and CPT procedure codes, wherein upon entering and updating information, the electronic medical record

system filed the patient's record in real-time in the patient data repository (Abstract, lines 1-2; Fig. 2-3, 5-6, and 14, col. 5 lines 1-27, col. 6 line 55 to col. 7 line 5, col. 9 lines 1-14).

It is noted that Evan's discloses recording insurance information as well as diagnosis and procedure codes within a patient record as discussed above (Abstract, lines 1-2; Fig. 2-3, 5-6, and 14, col. 5 lines 1-27, col. 6 line 55 to col. 7 line 5, col. 9 lines 1-14). As this information is most frequently used for billing purposes (i.e., billing insurance companies), it is respectfully submitted that this information within the patient record is a form of a "billing record." Furthermore, as per the recitation of "the billing record corresponding to standards in the industry," it is noted that ICD9 codes and CPT codes are widely accepted codes used to report and index medical records and are considered to be the standard codes set for reporting health care services in electronic data transactions.

(E) Claims 33-38 and 40-41 differ from method claims 21-29 and 32 by reciting hardware elements, namely, a computer readable medium and computer program code which is executable. As per these elements, Evans discloses:

(a) a multi-processor personal computer having 20 GB of storage capacity (col. 12 line 66 to col. 13 line 30); and

(b) applications running under Microsoft ® Windows <sup>TM</sup> to access data from a variety of data sources (col. 13 line 57 to col. 14 line 25).

Claim 33 recites "indicating any cost modification for the diagnosis or procedure indicated on the customizable form different from a cost typically billed by the particular healthcare provider for the diagnosis or the procedure indicated on the customizable form."

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Provost discloses this feature. Note the teachings of col. 11 lines 19-49:

"When server system 14 informs client system 10 that a submitted claim is in a condition for payment, the server system can transmit information that specifies the amount that will be paid by the insurer on behalf of the patient. For example, claim form 12B of FIG. 3 includes a field 50 that displays a dollar amount when the server system has determined that the claim is in condition for payment. In the example of FIG. 3, fields 52 permit the medical technician to enter an amount that is requested for the treatments defined by the treatment codes in fields 46.

To illustrate, the medical technician might enter in field 46 a treatment code that represents a physical exam performed by a physician. The medical technician could then enter in field 52 a dollar amount, such as \$100, that is customarily charged by the physician for a physical exam. Field 54 sums all dollar amounts entered in fields 52. In this example, if the physical exam was the only treatment rendered to the patient, field 54 would also display a dollar amount of \$100. If the server system, when processing the submitted claim, determines that the patient's insurer pays only \$90 for a physical exam, field 50 displays the dollar amount of \$90 when the insurance claims has been processed and returned to the client system. A balance due field 56 displays the difference between the total charge field 54 and the amount paid field 50. The dollar amount displayed in field 56 represents the amount that is to be collected from the patient. As used herein, the term "co-payment" is defined to extend to the dollar amount displayed in field 56, representing the amount that is to be collected from the patient beyond the payment that is approved by the insurer."

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Provost within the method taught collectively by Evans, Feldon, and Lavin with the motivation of reducing the number of insurance claims that are rejected by an insurance company (Provost; col. 2 lines 27-57) and decreasing the amount of time to determine whether a claim will be paid (Provost; col. 2 lines 27-57).

The remainder of claims 33-38 and 40-41 repeat the same limitations as claims 21-29 and 32, and are therefore rejected for the same reasons given for those claims, and incorporated herein.

(F) Claims 42-43 repeat the limitations of claims 21 and 33, and are therefore rejected for the same reasons as those claims.

***Response to Arguments***

4. Applicant's arguments filed May 29, 2007 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed May 29, 2007.

(A) At page 16 of the May 29, 2007 response, Applicant argues that none of the references cited, alone or in combination, teaches or suggest such limitations.

In response, the Examiner respectfully disagrees. As per claims 21, 33, and 42, examiner maintains rejections detailed in the previous office action.

(B) At pages 17-18 of the May 29, 2007 response, Applicant argues that Lancelot fails to teach the amended features of independent claims 21, 33, or 42 as follows: defining specifications relating to the pool of healthcare procedures, defining specifications relating to the one or more healthcare diagnoses, displaying a reference to the customizable form in a searchable field within a form definition window, populating one or more fields of the form definition window, displaying the form definition window with the populated fields, entering procedure and diagnosis codes, and displaying a preview of the customizable form.

In response, the Examiner respectfully disagrees. It is readily apparent that Lancelot discloses defining specifications relating to the pool of healthcare procedures, (column 1, lines 53-57), defining specifications relating to the one or more healthcare diagnoses, displaying a reference to the customizable form in a searchable field within a form definition window, (column 3, lines 16-25), populating one or more fields of the form definition window, (column 3,

lines 29-39), displaying the form definition window with the populated fields, (column 4, lines 19-36), entering procedure and diagnosis codes, (column 6, lines 16-23), and displaying a preview of the customizable form, (column 4, lines 53-67). Thus, the Examiner respectfully contends that the method and system taught in the Lancelot reference is an art recognized equivalent to Applicant's defining specifications relating to the pool of healthcare procedures, defining specifications relating to the one or more healthcare diagnoses, displaying a reference to the customizable form in a searchable field within a form definition window, populating one or more fields of the form definition window, displaying the form definition window with the populated fields, entering procedure and diagnosis codes, and displaying a preview of the customizable form.

(C) Applicant asserts that the corresponding dependent claims set forth different aspects related to the same general concept as claims 21, 33, and 42. The corresponding dependent claim are dependent from Applicant's independent claims 21, 33, and 42. As such, Applicant's remarks with regard to the application of Evans, Feldon, Lavin, Provost, and Lancelot to these claims is moot in the above Office Action.

5. Applicant's arguments with respect to claims 21-29, 32-38, and 40-43 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches Method and apparatus for reporting emergency incidents (US 6594634 B1), Automatic report generating system (US 6055541 A), Method for automated collection of psychotherapy patient information and generating reports and treatment

plans (US 6338039 B1), Knowledge-based expert interactive system for pain (US 5908383 A), Collapsible flowsheet for displaying patient information in an electronic medical record (US 5950168 A), Method of managing and controlling access to personal information (US 6073106 A), System for and method of collecting and populating a database with physician/patient data for processing to improve practice quality and healthcare delivery (US 6151581 A), Systems, methods and computer program products for guiding the selection of therapeutic treatment regimens (US 6081786 A).

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amber L. Altschul whose telephone number is 571-270-1362. The examiner can normally be reached on M-F 8:30-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALA

August 23, 2007

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